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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,838	09/17/2003	Rocky R. Arnold	20843-002110US	4910
20350	7590	08/02/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LEVI, DAMEON E	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 08/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,838

Applicant(s)

ARNOLD ET AL.

Examiner

Dameon E Levi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s), filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to the Office, due to the lack of the "comprising of" or "consisting of" as to what is included or excluded in the claim language. Claims 2-9 are also seen as indefinite owing to their dependence from claim 1. Additionally, claim 7 recites the limitation "formable polymer sheet" in claim 1. There is insufficient antecedent basis for this limitation in the claim. The art rejections that follow herein below are as best understood by the Office.

Regarding claims 15-21, it is unclear to the Office whether an EMI/RFI shield or a method of forming an EMI/RFI shield is claimed. The claims are interpreted as best understood by the Office to be method claims and the Rejections set forth regarding claims 15-21 follow as such below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5,7,and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Forte et al US Patent 6674652.

Regarding claim 1, as best understood by the Office, Forte et al discloses EMI/RFI shield integrally formed in a thermoformable sheet, wherein portions of the thermoformable sheet are removed around a periphery of the EMFRFI shield, wherein the portions of the thermoformable sheet that are not removed integrally connect the EMI/RFI shield to a remainder of the thermoformable sheet(for example, see elements 400,402, 404, Figs 2,3). Additionally, a “wherein” clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. In this instance regarding claim 1, since the “wherein” clause was not used to related back and clarify the limitations of a previous claim from which it depends it does not limit the claim.

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Regarding claim 2, as best understood by the Office, Forte et al discloses wherein the EMI/RFI shield comprises at least one layer of a conductive material(for example, see column 4, line 41 – column 5, line 50).

Regarding claim 3, as best understood by the Office, Forte et al discloses wherein the EMI/RFI shield is multi-compartmentalized(for example, see column 4, lines 52-63).

Regarding claim 4, as best understood by the Office, Forte et al discloses wherein the EMI/RFI shield defines a single compartment(for example, see column 4, lines 52-63).

Regarding claim 5, as best understood by the Office, Forte et al discloses wherein the layer of conductive material comprises at least one layer of tin, aluminum, copper, and nickel(for example, see column 4, line 41 – column 5, line 50).

Regarding claim 7, as best understood by the Office, Forte et al discloses wherein the formable polymer sheet comprises a recycled, conductively coated polymer EMVRFI shield that has been mechanically disintegrated and then recombined back into the formable polymer sheet(for example, see elements 400,402, 404, Figs 2,3, see column 4, line 41 – column 5, line 50).Additionally, the limitations [a recycled, conductively coated,as well as, mechanically disintegrated and then recombined back] are process limitations in a product claim and cannot serve to patentably define the product over the prior art of record [Forte et al, Isern-Flecha et al]; [see Product –by-process, MPEP 2113 and 2173.05(p)]It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art , cannot impart patentability to that product.(In re Johnson, 157 USPQ 670, 1968).

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Regarding claim 8, as best understood by the Office, Forte et al discloses where the mechanically disintegrated EMI/RFI shields comprise a metallized film comprising one of a painted film, a vacuum metallized film, and an electroless plated film (for example, see elements 400, 402, 404, Figs 2, 3, see column 4, line 41 – column 5, line 50). Additionally, the limitations [mechanically disintegrated, metallized, painted, vacuum metallized, electroless plated] are process limitations in a product claim and cannot serve to patentably define the product over the prior art of record [Forte et al, Isern-Flecha et al]; [see Product –by-process, MPEP 2113 and 2173.05(p)] It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (In re Johnson, 157 USPQ 670, 1968).

Claims 10-14 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Long US Patent 6359213

Regarding claim 10, Long discloses a reel comprising:

a sheet of material; a spool that receives the sheet of material; and a plurality of EMI/RFI shields attached to the sheet of material that is rolled on the spool (for example, see Figs 1, 2, 3).

Regarding claim 11, Long discloses wherein the EMI/RFI shields are integrally attached to the sheet of material (for example, see Figs 1, 2, 3).

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Regarding claim 12, Long discloses wherein the EMI/RFI shields are attached to the sheet of material with tabs of material (for example, see Figs 1,2,3 see column 2, line 25 – column 3, line 25).

Regarding claim 13, Long discloses wherein the EMVRFI shields comprise at least one layer of conductive material (for example, see Figs 1,2,3, see column 2, line 25 – column 3, line 25).

Regarding claim 14, Long discloses herein the EMI/RFI shields and sheet of material comprise recycled material (for example, see Figs 1,2,3, see column 2, line 25 – column 3, line 25).

Moreover, the limitation [comprise recycled material] is a process limitation in a product claim and cannot serve to patentably define the product over the prior art of record [Long]; [see Product –by-process, MPEP 2113 and 2173.05(p)]

It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (In re Johnson, 157 USPQ 670, 1968).

Regarding claim 22, Long discloses wherein the tabs of material are perforated (for example, see Figs 1,2,3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al US Patent 6674652 in view of Isern-Flecha et al US Patent 5557064.

Regarding claim 6, as best understood by the Office, Forte et al discloses the instant claimed invention except wherein the conductive material comprises a vacuum metallized first layer of tin and an electroplated second layer of tin.

Isern-Flecha et al discloses an EMI/RFI shield wherein the conductive material comprises a vacuum metallized first layer of tin and an electroplated second layer of tin (for example see elements 10,20,30,40,16,32, Figs 1-4, see column 3, line 3 – line 65)

Moreover, the limitation [vacuum metallized, and electroplated] are process limitations in a product claim and cannot serve to patentably define the product over the prior art of record [Forte et al, Isern Flecha et al]; [see Product –by-process, MPEP 2113 and 2173.05(p)]

It is well settled that the presence of process limitations in product claims, which product does not otherwise distinguish over the prior art, cannot impart patentability to that product. (In re Johnson, 157 USPQ 670, 1968).

Although Isern-Flecha does not expressly disclose the first and second layers being of tin, it is the position of the Office that, given the teachings of Isern-Flecha, one skilled in the art at the time the invention was made would have contemplated the use of tin to

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comprise the layers of conductive material as taught by Forte et al since tin is a metal that is well known in the art for EMI/RFI shielding purposes.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al US Patent 6674652 in view of Gabower et al US Patent 6624432.

Regarding claim 9, as best understood by the Office, Forte et al discloses the instant claimed invention except wherein the EMI/RFI shield comprises a top surface, a plurality of sidewalls extending at an angle from the top surface and a flange around a periphery of the side walls, wherein the flange and the top surface define substantially parallel planes.

Gabower et al discloses an assembly wherein an EMI/RFI shield comprises a top surface, a plurality of sidewalls extending at an angle from the top surface and a flange around a periphery of the side walls, wherein the flange and the top surface define substantially parallel planes(for example, see elements 21, Figs 2-6)

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the shields in the manner as taught by Gabower et al in the assembly as taught by Forte et al as such arrangements are known in the art in order to accommodate electronic components.

Claim 15-21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al US Patent 6674652 in view of Isern-Flecha et al US Patent 5557064 and further in view of Gabower et al US Patent 6624432.

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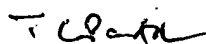
Regarding claims 15-21,as best understood by the Office the methods disclosed therein are deemed as inherent in the assembly of the claimed EMI/RFI apparatus of the preceding claims as fully met by the accompanying references, (Forte et al, Isern-Flecha et al, Gabower et al) and are subsequently rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E Levi whose telephone number is (571) 272-2105. The examiner can normally be reached on Mon.-Fri. (9:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tulsidas C Patel can be reached on (571) 272-2098. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dameon E Levi
Examiner
Art Unit 2841



TULSIDAS PATEL
PRIMARY EXAMINER

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